



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

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Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/093,972 08/09/98 NYCE

J F6641031

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HM12/0723

EXAMINER

FPPS..I

ART UNIT	PAPER NUMBER
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1635

DATE MAILED:

07/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.

09/093,972

Applicant(s)

NYCE, JONATHAN W.

Examiner

Janet L Epps

Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 July 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 04 May 2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Attached Sheet and the notice of non-compliance Amendment 37CFR 1.121

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 108-131, 133, 134, 146, 148, 151-156, 161-163 and 232-234.

Claim(s) objected to: _____.

Claim(s) rejected: 164-231 (for reasons of record)

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

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1. Applicants proposed amendments to the specification, particularly on pages 37-38, do not comply with 37 CFR 1.121(b)(1)(ii) since applicants have not provided a clean version of the replacement paragraphs. See the attached notice of non-compliant amendment.
2. Applicant's amendment to claim 183 potentially raises the issue of new matter. Applicants proposed amendment reciting "liquid nucleic acid particles less than about 5 μ or greater than about 10 μ in size." The specification (page 48) recites wherein respirable particles range from about .5 microns to 10 microns in size. Applicant's proposed amendment is considered new matter since there is no support for the particular range which includes the language "less than about 5 μ " or "greater than about 10 μ ."
3. Claims 164, 173, 185-187, and 221-222 were amended to recite "increased levels of, adenosine or adenosine receptors," instead of "increased levels of adenosine." This amendment raises new issues that would require further consideration due to new matter since the specification as filed does not support a method for treating hyper-responsiveness to adenosine receptors.
4. Claim 200 is amended to recite [(b) obtaining a first [oligo] target nucleic acid segment 4 to 60 nucleotides long [which] that comprises the selected fragment and has a [C and G] T or U nucleic acid content of up to and including about 15%; and (c)]. This amendment does not comply with 37 CFR 1.121 since there is underlining and bracketing within a set of brackets. It is unclear what exactly applicants are attempting to amend. See the attached notice of non-compliant amendment.

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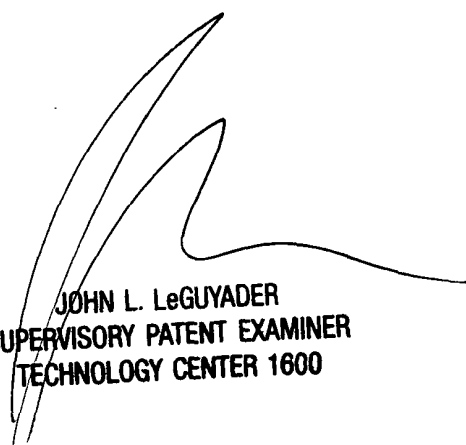
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L Epps whose telephone number is 703-308-8883. The examiner can normally be reached on Mondays through Friday, 9:00AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader can be reached on (703)-308-0447. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-746-5143 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Janet L Epps
Examiner
Art Unit 1635

jle
July 23, 2001



JOHN L. LeGUYADER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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6-09-98

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EXAMINER

J. EPS

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1635

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DATE MAILED:

Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment filed on 7-12-01 is considered non-compliant because it has not been submitted in the format required under 37 CFR 1.121, as amended on September 8, 2000 (see 65 Fed. Reg. 54603, Sept. 8, 2000, and 1238 O.G. 77, Sept. 19, 2000).

- ☒ 1. The amendment does not include a clean version of the replacement paragraph(s)/section(s). 37 CFR 1.121(b)(1)(ii).
- ☐ 2. The amendment does not include a marked-up version of the replacement paragraph(s)/section(s). 37 CFR 1.121(b)(1)(iii).
- ☐ 3. The amendment does not include a clean version of the amended claim(s). 37 CFR 1.121(c)(1)(i).
- ☐ 4. The amendment does not include a marked-up version of the amended claim(s). 37 CFR 1.121(c)(1)(ii).
- ☒ 5. Other Claim 200 contains improper bracketing & underlining.
- ☐ **PRELIMINARY AMENDMENT:** Unless applicant re-submits the preliminary amendment in compliance with revised 37 CFR 1.121 within ONE MONTH of the mail date of this letter, examination on the merits may commence without entry of the originally proposed preliminary amendment. This notice is not an action under 35 U.S.C. 132, and this ONE MONTH time limit is not extendable.
- ☐ **AMENDMENT AFTER NON-FINAL ACTION:** Since the above mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

For your convenience, attached to this correspondence is a copy of an informational flyer (MPEP Bookmark Bulletin on "Simplified Amendment Practice").

Legal Instruments Examiner